



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 09/611,548 Confirmation No.: 6763  
Applicant: Douglas G. Lowenstein, et al.  
Title: FINANCING OF TENANT IMPROVEMENTS  
Filed: July 7, 2000  
Art Unit: 3691  
Examiner: Narayanswamy  
Subramanian  
  
Atty. Docket: 1906-3-Polestar  
Customer No. 68536

**PETITION REQUEST FOR WITHDRAWAL OF OFFICE ACTION OF  
FEBRUARY 19, 2010 AND REFUND OF PETITION AND EXTENSION FEES**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Request for Withdrawal of Office Action

Applicant hereby requests withdrawal of the Office Action of February 19, 2010 since it did not examine the claims as amended and did not answer all material traversed.

More particularly, the Office Action of February 19, 2010 is designated a non-final action by the box 2b checked on the Office Action Summary sheet and the Petition decision issued on March 30, 2010 states "the finality of the Office action dated October 3, 2008 was also improper." Thus, it is undisputed that finality was withdrawn. Applicant is entitled to have any amendments to claims presented entered as of legal right as long as the application is not finally rejected. This is also undisputed.

08/24/2010 HVUONG1 00000034 503219 09611548  
02 FC:1462 400.00 DA

The “Amendment and Reply to Office Action” of November 5, 2009 should have been entered. Therefore, the correct claims as amended are in Claims Appendix Two of that filing. (A copy of Claims Appendix Two is attached to the Response filed concurrently for convenience.) The Petition filed July 7, 2010, at least at page 25, line 27-29 to page 26, lines 1-2, and page 36 at lines 3-5, requests and argues for withdrawal of finality. The Amendment of November 5, 2009 at page 4, lines 6-7, states “The amendments presented in Claims Appendix Two to this paper should be entered.” The Amendment of November 5, 2009 at page 4, lines 12-14, states “... and this paper (particularly the amendments of Claims Appendix Two) may be entered under 37 C.F.R. §1.111 as of right with no extension of time.” The Amendment of November 5, 2009 at page 5, line 20, states “AMENDMENTS TO THE CLAIMS begin at page begin on page [sic] 81 of this paper.” Page 81 is the first page of Claims Appendix Two. The Amendment of November 5, 2009 at page 40, lines 32-33, states “This paper is a reply to Office Action, and the amendments in Claims Appendix Two should be entered.” Thus, it is clear Applicant was presenting claim amendments in Claims Appendix Two.

The Patent Office has not entered the Amendment of the claims in Claim Appendix Two of the filing of November 5, 2009 and has not examined the claims as amended. There is no express statement in the Office Action of February 19, 2010 that the claim amendments in Claim Appendix Two of the filing of November 5, 2009, were entered or considered. Additionally, the claim amendments should have eliminated many of the concerns stated in the rejections in the Office Action of February 19, 2010. The quotes of claim language in the Office Action always stop short of reciting the amended language immediately following the quoted language. There is no explanation in the rejections as to why the claim amendments do not eliminate the concerns expressed in the rejections. Thus, it is apparent from reading the Office Action of February 19,

2010 that the Examiner was not examining the claims as amended. The Office has erred by not considering the claims as amended November 5, 2009.

The claims in Claims Appendix Two should have been examined. The Office Action of February 19, 2010 does not move the case forward. Applicant is now in the position of responding to an Office Action that did not even address the correct claims. This further complicates a case that has already been pending for 10 years and is already procedurally complicated. The procedure in the case will be simplified if the Office Action of February 19, 2010 is withdrawn. Furthering the prosecution of the wrong claims is futile and a waste of time, effort and money; but the Office has subjected the Applicant to this burden, including PTO fees and attorney fees.

The Office Action should be withdrawn for the additional reasons stated in the email communications to SPE Kyle and the Interview Summary with SPE Kyle (Exhibits 1 and 2) incorporated herein by reference.

Applicant respectfully requests that the Office Action of February 19, 2010 be withdrawn and that the Patent Office examine the amended claims in Claims Appendix Two (copy attached to the Response filed concurrently, for convenience) in a new Office Action.

Request for Refund of Patent Office Petition and Extension Fees

As set forth above, it is abundantly clear that the Patent Office erred in not entering the amendments to the claims in Claims Appendix Two of November 5, 2010, and by not examining the amended claims. Applicant never should have been put to the task of responding to this Office Action directed at the wrong claims.

Applicant's attorney felt that this was the sort of issue that could easily be resolved by contacting the Patent Office and explaining the problem, so that the Office Action could be withdrawn without Applicant having to go through the onerous and expensive task of responding to an Office Action that does not even address the correct set of claims. It is expensive in terms of Patent Office extension fees, this petition's fees and attorney fees for this response to be filed.

Applicant's attorney contacted the Patent Office (SPE Klye) by email on August 10, 2010 (copy of the email communications attached in Exhibit 1) and in a telephone interview on August 18, 2010 (copy of Applicant's Interview Summary attached in Exhibit 2). Applicant's attorney requested that the Office Action be withdrawn for the reasons set forth above and set forth in the email communications and Interview Summary (Exhibits 1 and 2) incorporated herein by reference. Applicant's attorney offered to walk SPE Klye through this fairly simple procedural issue including the requests that the amendments be entered, the withdrawal of finality in the Office Action and the Decision of March 30, 2010, and the portions of the Office Action which seem to not be aware of the amended claim language. Applicant's attorney estimated that it would only take a few minutes. SPE Klye refused to withdraw the Office Action and required the Applicant to file a response at great expense to the Applicant.

This response has cost the Applicant thousands of dollars because SPE Klye refused to take the time on the telephone to walk through the papers with Applicant's attorney to simplify the case and relieve the Applicant of the financial burden the Patent Office's error has placed on Applicant. This is the sort of error (an Office Action that does not enter an amendment and addresses the wrong claims) that an SPE should attempt to correct if it comes to his attention in any way. He should attempt to correct it sua sponte even if it comes to his attention in an email communication or any other round about way.

Applicant's attorney explained the financial burden on Applicant of filing a response but SPE Kyle refused to make a decision over the telephone or walk through the relevant portions of the papers with the guidance of Applicant's attorney and said Applicant should file a response. The bureaucratic mindset where Patent Office employees impose these financial burdens on Applicants devoid of the reality that the country is in the worst economic recession in 70 years is unfair and should not be permitted. It amounts to abuse of the administrative legal proceedings where Applicant's legal fees are knowingly unnecessarily increased.

Since the initial error was that of the Patent Office in not entering the amended claims and issuing an Action that addresses the wrong claims, and since the error could have been easily resolved by SPE Kyle withdrawing the Office Action by taking five minutes to type and to fax a statement of withdraw to Applicant's attorney; Applicant should never have had to respond or to petition this issue. Applicant should never have had to pay this petition fee of \$400.00 and should never have had to pay the extension fees of \$555.00.

Applicant requests refund of the extension fees of \$555.00 and waiver or alternatively, refund of the petition fee of \$400.00 authorized below.

Please note that even a refund of all fees does not make the Applicant whole because Applicant has had to incur legal fees. SPE Kyle seemed to callously disregard that burden placed on the Applicant is refusing to withdraw the Office Action when requested. This seems to be a case of abuse of the administrative legal process.

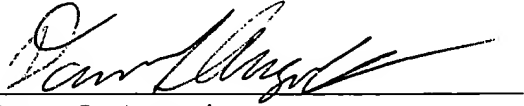
Fee

The petition fee under 37 CFR 1.17(f) for a decision not specifically provided for is \$400.00 for a small entity. Authorization is given to charge the fee of \$400.00 to Deposit Account No. 503219. A duplicate of this sheet is enclosed.

Authorization is given hereby to charge any deficiency or credit any overpayment in the enclosed fee, or charge any additional extension of time fees necessary to preserve the pendency of the subject application, to Deposit Account No. 503219.

Respectfully submitted,

Dated: August 19, 2010

By:   
Donna L. Angotti  
Registration No. 32,679

Attorneys for Applicant  
LAW OFFICES OF DONNA ANGOTTI  
140 Broadway, Suite 4600  
New York, NY 10005  
(212) 858-7515  
(212) 858-7750 (FAX)